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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,466	05/23/2001	Mark Landesmann	084561-0106	7474
22428	7590	04/11/2006	EXAMINER	
FOLEY AND LARDNER LLP			CHAMPAGNE, DONALD	
SUITE 500			ART UNIT	
3000 K STREET NW			PAPER NUMBER	
WASHINGTON, DC 20007			3622	

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,466

Applicant(s)

LANDESMANN, MARK

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-122 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-122 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 13 October 2005 have been fully considered, but the arguments against the art rejection are not persuasive. Applicant argued (pp. 25-27) that Walker et al. (US 20040039639A1) could not claim the benefit of its parent application filing date (9 July 1999) because of a break in continuity. Applicant was correct, but the claim to the parent application filing date has since been perfected by a petition decision mailed on 29 December 2005. A copy of that decision is hereby made of record in the instant case.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20, 22, 23, 27-34, 38-40, 47, 52-54, 62-81, 83, 84, 88-95, 99-101, 108 and 113-115 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US 20040039639A1).
5. Walker et al. teaches (independent claims 1, 7, 62 and 68) a method and system for incensing submission of purchase information for a goods or service, and for providing at

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least one benefit to buyer entities with a serious intent to purchase a good or service, the method for providing at least one benefit comprising the steps of: receiving from a buyer entity a declaration of intent to purchase a good or service (*a potential buyer provides a central server a description of an item he intends to purchase*); providing to the buyer entity an offer of benefits whose value is partly or fully contingent on receipt of proof of said purchase within as predetermined period of time (*Either the potential buyer or the central server specifies a time period in which the item is to be purchased. In exchange for the information provided, the potential buyer is offered a reward, such as a gift or a discount.*); receiving said proof of purchase from the buyer entity and providing the value of said contingent benefits to the buyer entity (para. [0010]).

6. Walker et al. does not explicitly teach that the value of the offer of benefits is not contingent on fulfillment of the requirement that the purchase be made from one particular predetermined manufacturer. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted, first, that the reference does not teach this negative limitation. Second, the reference does teach manufacturers in the plural: *The value of the reward may be based upon the amount and specificity of the information provided by the potential buyer, and/or the value of this information to sellers, such as manufacturers, retailers and distributors* (para. [0010]).
7. Walker et al. also teaches at the citations given above claims 2 and 63, 8 and 69, 11 and 72, and 20 and 81.
8. Walker et al. also teaches: claims 3, 15, 16, 19, 29, 30; 64, 76, 77, 80, 90 and 91 (para. [0067]); claims 4, 14, 22, 32, 33, 65, 75, 83, 93 and 94 [0053]; claims 5, 12, 66 and 73 [0029]; claims 6, 39, 40, 67, 100 and 101 [0070]; claims 9, 10, 13, 23, 34, 70, 71, 74, 84 and 95 [0024]; claims 17, 18, 27, 28, 31, 38, 78, 79, 88, 89, 92 and 99 [0056]; claims 47 and 109 [0030]; claims 52, 53, 113 and 114 ([0025] and sections cited above); and claims 54 and 115 [0041].
9. Note on interpretation of claim terms Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation

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that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

10. The instant application contains no such clear definitions for many key claim terms. For example, "system" and "component" without further qualification from the specification must be interpreted very broadly, which leads to the rejection above under 35 U.S.C. 101 for claims 62-122. Applicant can overcome this rejection by adding a technology limitation from the specification (i.e., a computer at at least one place in the body of each claim).
11. As further examples: Any analysis of the intent rating, such as that given in reference para. [0056], reads on obtaining and comparing the "threshold" serious intent rating (claim 17). Also, the intent to purchase any amount (including one unit) reads on the intent to purchase "at least a specified volume of a product" (claim 8), since the buyer has inherently specified the amount with their intention.
12. Ownership limitations – Patents are granted for technological distinctions. Differences in ownership are not technological distinctions, and therefore cannot make a claim patentable. Hence no patentable weight could be given to "a third party" and a "third party source". Formally, differences in ownership are not statutory matter (MPEP 2106.IV.B.2(b) at p. 2100-15 to -18 revised May 2004).
13. Claims 21, 24-26, 35-37, 41-46, 48-51, 55-61, 82, 85-87, 96-98, 102-107, 109-112 and 116-122 are rejected under 35 U.S.C. 103(a) as being obvious over Walker et al. (US 20040039639A1).
14. Walker et al. does not teach (claims 21 and 82) charging the advertiser that provides benefits commensurate with the serious intent rating. Because the advertiser is the sponsor and Walker et al. teaches [0025] that rating is a measure of the value to the sponsor, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Walker et al. that the advertiser be charged commensurate with the serious intent rating.

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15. Walker et al. does not teach (claims 24-26 and 85-87) basing the rating on the actual/declared number of purchases/amount spent. Because all are obvious and mathematically related measures of intent, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Walker et al. that the rating be based on the actual/declared number of purchases/amount spent.
16. Walker et al. does not teach (claims 35-37, 41, 42, 96-98, 102 and 103) cookies. Because cookies are well-known means for efficiently storing user-marketing data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add cookies to the teachings of Walker et al.
17. Walker et al. does not teach (claims 43-46 and 104-107) providing a benefit only if a presented ad/video is watched. Because ads are a common means of measuring intent (by watching for a click-through), and there is no point to rewarding a user that does not exhibit positive intent, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Walker et al. that a benefit be provided only if a presented ad/video is watched.
18. Walker et al. does not teach (claims 48-51 and 109-112) using the methods of panel research to determine the rating. Because panel research is a well-known means for marketing research, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Walker et al. that the methods of panel research be used to determine the rating.
19. Walker et al. does not teach (claims 55-61 and 116-122) using the intent to discontinue a purchase to determine a benefit to be offered. Because product substitutions can be beneficial to the sponsor and read on the intent to discontinue a purchase, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Walker et al. using the intent to discontinue a purchase to determine a benefit to be offered.

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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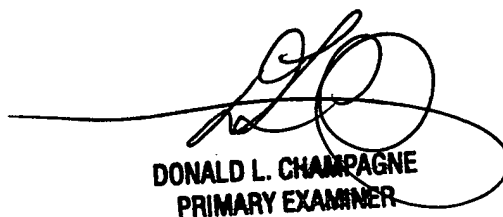
21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
23. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
25. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues,

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or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

26. Applicant may have after final arguments considered and amendments entered by filing an RCE.

27. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.


DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

8 April 2006